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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,796	01/07/2000	NAREN CHAGANTI	PSCO-005	2169

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EXAMINER

BARRON JR, GILBERTO

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 11/29/2001

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/478,796

Applicant(s)

CHAGANTI ET AL.

Examiner

Gilberto Barrón Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. The Response filed August 27, 2001 has been carefully considered, but is not persuasive in overcoming the rejections presented in the Office action mailed May 23, 2001. The statement of the grounds of rejection will be re-presented below followed by responses to Applicant's arguments.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

3. Claims 26-30 are rejected under 35 U.S.C. 101 because the claimed invention is inoperative and therefore lacks utility. The instant claims have been amended and now recite "program of instructions to..." which is inoperative as program of instructions, in themselves, cannot provide any functionality. Programs of instructions when executed by a computer are operative to perform the function recited.
4. Applicant argues that the recitation of 'program of instructions' appears to be allowable practice in view of examples of issued patent claims is not persuasive. The instant claims do not correspond to the examples cited by Applicant (two are claiming systems and the remainder an article of manufacture that limits the program instructions to performance of a method), nor will the patentability of the instant claims be determined by a comparison of form rather than examination of the merits.

The instant claims are directed to a program storage device that tangibly embody a program of instructions. There is no recitation that provides for the program storage

device to functionally cause a computer to implement a statutory method. The recitation of program of instructions appears to be directed to a listing of instructions and not to a computer readable medium for causing a computer to execute the method steps of a statutory process.

Claim Rejections - 35 USC § 112

5. Claims 1-5 and 7-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims are indefinite because the method steps recited in the claims are in "steps plus function" form which invoke 35 U.S.C. 112, sixth paragraph, but applicant has failed to provide a description or indicate where support in the specification is to be found, of the corresponding acts, or the equivalents thereof, to allow determination of the scope of the claims.

6. Claims 1-5 and 7-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant claims recite method steps which are in "step plus function" form, which invoke 35 U.S.C. 112, sixth paragraph, but there is no indication of where support for the corresponding acts, or equivalents thereof, are to be found in the specification. Applicant is required to point out where support for the "step plus functions" acts is to be found.

Response to Arguments

7. Applicant is correct in that the Office Action of May 23, 2001 did raise a new ground of rejection, which is appropriate in a first action on the merits following the RCE submission of November 13, 2000.

However, Applicant's argument is unclear since the response appears to merely cite guidelines for regarding 112, 6th paragraph. The examiner's position was that the claims recited methods, used the phrase "steps" and, finally, recited functional language without specifying acts for achieving the stated function. These three guidelines indicate that claim interpretation invokes 112, 6th paragraph. However, there is no clear indication of what part of the specification describes the acts that correspond to the stated functions.

If Applicant's position is that no 112, 6th paragraph limitations are to be invoked, nevertheless, the rejection under 112, 1st paragraph should be addressed and indication of what part of the specification describes the claimed invention is required. The instant claims will not be limited to those acts described, but will provide guidance that the specification describes the claimed invention.

Claim Rejections - 35 USC § 103

8. Claims 1-5, 14-16, 19-21 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry et al. (5,241,466) in view of Smith (4,956,769).

The Perry patent discloses a central depository for central information such as living will and other associated information. The Perry patent discloses establishing an

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account for the user with a server computer; see Fig. 1, computer 10 and col. 3, lines 46-64. The method of claim 1 and 25 is disclosed by the Perry patent as follows. The step of assigning an identifier is disclosed at col. 5, line 2. The step of entering personal information is disclosed at col. 4, lines 50-68. The step of storing in the database the customer file is disclosed at col. 4, lines 10-18 and 67-68. The step of receiving a request message from a requester is disclosed at column 8, lines 36-44. The step of retrieving from the database the information is disclosed at col. 8, lines 58-66. The step of securely transmitting the information is disclosed at col. 8, line 67 thru col. 9, line 7.

However, the Perry patent does not disclose the step in claim 1 of assigning a security level to each information object nor the claim 4 step of designating the requester as a junk requester if a predetermined number of requests are not authorized.

The patent to Smith teaches a security protection system for a computer database wherein users are given security profiles and the data is stored with data fields for limiting the access to users of the information stored therein, see col. 1, line 58 thru col. 2, line 10. The Smith patent also teaches a protection step of generating an alarm if a predetermined number of unauthorized requests are detected; see col. 6, lines 1-34.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the security system of the personal information database disclosed in Perry by providing for assigning a security level to the information object and generating an alarm if a predetermined number of unauthorized attempts are made

as taught in Smith in order to provide a computerized database with the security against users attempting fraud. See Smith at col. 1, lines 24-47.

Claims 2 and 27, the step of requester authorization and verification is disclosed at col. 8, lines 45-52 of Perry.

Claims 3, the step of requester not authorized and rejected is disclosed at col. 8, lines 54-57 of Perry.

Claims 5 and 28-30, the step of recording every access to a user's information is disclosed at col. 7, lines 36-38 of Perry.

Claims 14 and 15 are met by Perry at col. 2, lines 55-57 and col. 6, line 68 thru col. 8, line 35 which disclose updating to meet the recitation of altering the user's personal information.

Claim 16, Perry teaches a computerized database to meet the recitation of a communication network.

Claim 19, Perry discloses personal information to meet the recitation of the particular types of information recited herein.

Claims 20 and 21, Perry discloses receiving an authorization request from the requester and verifying the request at col. 2, lines 43-54.

Claim 24, Perry discloses a periodic status report at col. 7, lines 1-4.

Claim 26, Smith discloses using plural security clearance levels such as user ID as a first security clearance level and terminal location as a second security clearance level. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the access procedure in Perry to provide for plural levels

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of security clearances which must be cleared by a requester as taught in Smith in order to secure the computerized database against attempted fraud, see Smith at col. 1, lines 24-47.

9. Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry in view of Smith as applied to claim 1 above, and further in view of Murphy (5,644,711).

Claim 7 provides for generating an authorization key, while the Perry patent discloses identifying particular authorized users. The Murphy patent teaches secure access to selected directories using user ID and a password, see col. 4, lines 14-38. The teaching of a password implies that an authorizing key is generated by the method. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for authorization keys such as passwords as taught in Murphy for the select access to particular objects as taught in both Perry and Murphy in order to provide a security measure for access to select portions of a database, see col. 6, lines 15-24 of Murphy.

Claims 8-13 are disclosed in Perry as the particular information requested is checked to see if the particular requester is authorized access to the information, see col. 8, lines 45-57. Further, Smith teaches that particular requester characteristics or attributes such as terminal location and type of information requested are part of the information request.

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10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perry in view of Smith as applied to claims 1 and 16 above, and further in view of the Moozakis article entitled "Internet Printing Takes Hold".

The Perry reference does not disclose using the Internet Printing Protocol for transmitting information.

The article entitled "Internet Printing Takes Hold" describes IPP as a mechanism for transmission of information directly to a printer for distribution of information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the requested information in Perry under the Internet Printing Protocol as Perry discloses transmission of the information over a network, see col. 9, lines 1-7 and the article by Moozakis teaches information distribution by Internet Printing Protocol is an efficient manner for distributing information.

11. Claims 18 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry in view of Smith as applied to claim 1 above, and further in view of Vaudreuil (5,621,727).

The Perry reference does not disclose the secure e-mail or the executable query requests of the instant claims.

Vaudreuil teaches a network that transmits information securely using PEM or public key, see col. 28, lines 23-48 and also teaches a network that allows requests for information to be in a form executable for database searching, see col. 9, lines 20-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the transmission of the requested information disclosed

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in Perry by means such as PEM or public key as taught in Vaudreuil in order to secure the information from other parties and to send requests for information in an executable form such as SQL as taught in Vaudreuil in order to provide for searching of a database by automated means.

Response to Arguments re 103 rejection

12. Applicant's arguments that neither Perry nor Smith had both (1) different categories of a user's information; and (2) different security levels that could be applied at the granularity of an individual information object, is not persuasive. Applicant has not pointed to one claim that contains either or both limitations. There is no claim that specifies a user's personal information is partitioned into "different categories" or a limitation addressing how these categories provide a distinguishing feature over the prior art of record. There is no claim that specifies applying different security levels at the granularity of an individual information object. The claims only require "at least one" of "information objects" and "a plurality of security levels". These limitations clearly define a scope that allows for one information object and one security level to be applied to that object. Applicant's arguments are directed to limitations that are not required by the instant claims.

Response to Arguments re 102 rejection

13. The Rozen reference discloses two categories that are applied to personal information objects. Rozen also discloses applying one of two PIN's to the different categories to meet the limitations of "of assigning at least one of a plurality of security levels to each information object".

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14. Any affidavit to swear behind the effective date of the Rozen patent (priority provisional application date of October 30, 1997) would necessitate sufficient evidence of the claimed invention (conception of, or reduction to practice), not a partial showing, and due diligence, to overcome the instant rejection.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Mr. Albert Decady, can be reached on (703) 305-9595, or Ms. Gail Hayes, can be reached on (703) 305-9711.

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The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 746-7239.

The fax phone number for AFTER FINAL responses for the organization where this application or proceeding is assigned is (703) 746-7238.

The fax phone number for DRAFT proposals for the organization where this application or proceeding is assigned is (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

GILBERTO BARRÓN, JR.
PRIMARY EXAMINER
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